

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACKY JOACHIM, PHILIPPE ESPIARD,
BRUNO MAHIEUXE, ROGER GILBERT,
WOLFGANG HOLSTEIN and GERALD AMANNT

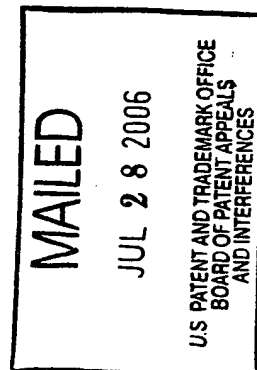
Appeal No. 2006-1868
Application No. 09/786,113

HEARD: July 12, 2006

Before WALTZ, KRATZ and FRANKLIN, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134. Accordingly, we remand this application to the examiner for further consideration and action not inconsistent with our opinion below. 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).



The rejected status of claim 21 reported in the answer and the briefs is inconsistent with the failure of the examiner to present a rejection of claim 21.

In this regard, we observe that the examiner indicates that an anticipation rejection of claim 21 over Lindemann et al. (U.S. Pat. No. 5,190,997) was rendered moot by an amendment filed by appellants. See the final office action mailed October 20, 2004 at page 2. The examiner maintains that no claims are allowed at page 8 of that same final action and includes claim 21 as a rejected claim in the Office Action Summary cover page, item No. 6. However, the examiner does not include independent claim 21 in any other rejection set forth in that final office action.

At page 1 of their brief, appellants furnish a footnote noting the lack of rejection of claim 21. At page 2 of the brief, appellants list claim 21 as a rejected claim in describing the status of the pending claims. Appellants do not conjecture as to the ground of rejection that the examiner had in mind and leave claim 21 out of the four rejections discussed in the brief and reply brief.

In response, the examiner does not clarify the record as to the status of claim 21 in the answer. Rather, the examiner continues the inconsistency as to the status of claim 21 by

submitting an answer that includes a statement (item No. 3) agreeing with the status of the claims presented by appellants in the brief without furnishing a new ground of rejection pertaining to claim 21 (if appropriate under current examining guidelines with the requisite approval). Nor did the examiner reopen prosecution to furnish the apparently intended rejection of claim 21 that was omitted from the final action or otherwise indicate a different status for claim 21.

We decline to speculate as to the examiner's intended rejection of claim 21 or to take part in a piecemeal presentation of the rejections being maintained on appeal. Accordingly, we remand this application to the examiner for correction of this anomaly in an appropriate manner consistent with current examination guidelines.

Additionally, we note that product-by-process claims 15 and 19 are rejected as being anticipated by U.S. Patent No. 5,190,997 to Lindemann et al. (Lindemann). However, the examiner has not fairly explained why the portions of the disclosure at column 5 and column 10 of Lindemann, as referred to in the rejection at pages 3 and 4 of the answer, sets forth subject matter with sufficient specificity for an anticipation rejection; that is, subject matter that rejected claims 15 and 19 read on. In this

regard, both of the so rejected claims require a mineral wool product component. The claims employ process steps in describing the claimed insulation product and require the formation of a mineral wool that has a thermosetting resin component. The claimed product is also limited by a specified hydrophillic latex component that was applied thereto prior to web formation. Yet, in the statement of rejection in the answer (pages 3 and 4), the examiner merely refers to the hydrophillic latex requirement of the product of claim 15 without addressing the mineral wool and thermosetting resin requirements of the claimed product. Nor does the examiner fairly relate how the disclosure at column 4, line 44, the background disclosure at column 3, lines 3-9, and the disclosure at column 10, lines 61-64 of Lindemann, as referred to in the answer in responding to appellants' arguments, establish (with or without the sections of the reference listed in the statement of rejection) that an anticipatory disclosure of the requisite specificity is, prima facie, presented in Lindemann.

We remand this application for further consideration of this anticipation rejection to the examiner primarily because of the disclosure in Example 13 of Lindemann. Example 13 furnishes a disclosure which has received scant attention by the examiner in

the answer in applying Lindemann as an anticipatory reference. In this regard, we note that Example 13 of Lindemann furnishes examples of a glass mat product that includes glass fibers that were deposited, via a slurry, through a scrim to form an unbounded mat. The unbounded mat is dipped in a bonding bath while sandwiched between scrim fabric layers, removed from the bath, dried and cured, and then treated to remove the scrim via peeling. Five different baths were alternatively used in treating the mats in Example 13 to form five separate products, including instances where a commercial U-F resin (a thermosetting resin) and an emulsion, such as a polyvinyl acetate emulsion copolymer, were employed.

Rejected claim 15 requires a product made using a thermosetting resin in addition to a homopolymer or copolymer that, as one option, was prepared from monomers that include one or more monomers having one or more hydrophillic functional groups. The claimed hydrophillic functional groups are required to be selected from hydroxyl, carboxyl or ester functional groups. Rejected claims 15 and 17 do not require any particularly specified amount of thermosetting resin or latex being added to the product. Nor do claims 15 and 17 require a particular glass fiber size used in the formed product or a

particular uniformity or non-uniformity of fiber sizes or distribution of added latex and resin.

The examiner should determine whether any of the Rhoplex GL 655, Suncryl SA-220, Suncryl RW 41SP, or the IPN polymer of Example 1, as alternatively used in Example 13, are encompassed by the hydrophillic polymer requirements of claim 15. In this regard, we note that claim 15 employs open "comprising" language and thus does not exclude the presence of other co-monomers being used that do not meet the one or more monomers requirement of claim 15 so long as at least one monomer that includes one of the listed functional groups is employed. The examiner should also determine whether or not the mineral wool formation requirement of claim 15 requires a product structure that is necessarily patentably distinct from the glass fiber mat of Example 13. If there is no product distinction that is reasonably apparent to the examiner based on such an analysis, the examiner should fully explain why one or more of the products recited in Example 13 of Lindemann would be expected to correspond to the claimed product and thus, fairly shift the burden to appellants to furnish evidence establishing such a product difference, in maintaining any anticipation rejection of the so affected product-by-process claims. If such an anticipation rejection is maintained, the

examiner should evaluate and fully respond to appellants' arguments in the briefs explaining why such arguments are unpersuasive. Appellants may take advantage of 37 CFR § 41.50 (a)(2)(i) in responding, if such an anticipation rejection is maintained in a supplemental answer.

Also, we remand the application to the examiner for further consideration of the obviousness rejections presented based on the examiner's detailed findings as to the teachings and suggestions of Lindemann respecting the use of a binder on a formed mat. The examiner should review the disclosure of Lindemann and explain in detail how Lindemann teaches using a binder that includes a thermosetting resin and a thermoplastic polymer that is made from at least one monomer of the claimed specified type and/or that includes a protective colloid as alternatively required by appellants' claims. Moreover, the examiner should fully explain how one of ordinary skill in the art would have applied the binders disclosed in Lindemann as being useful in treating a product including mineral wool or a process that makes such a product. In this regard, we note that Kajander suggests using a thermosetting resin in forming such a product. See Kajander at column 12, lines 32-45. If the examiner continues to rely on the wet laid fiber teachings of

Kajander, the examiner should fully explain how the teachings of Kajander respecting alternatively made wet laid fiber products would be viewed by one of ordinary skill in the art as being applicable to the known processes recited at column 12, lines 32-45 of Kajander, as well as the appealed subject matter, before attempting to combine those other teachings of Kajander with the column 12, line 32-45 disclosure thereof.

Also, on remand, the examiner should further review the teachings of the submitted prior art of record, obtaining English language translations where necessary, to determine if closer prior art exists, if such a review has not already taken place. In this regard, we note that several documents were listed as pertinent in the international preliminary examination report (IPER) submitted with the national stage application papers. See, e.g., Caccini et al. (U.S. Pat No. 5,968,645), which patent appears to correspond to the EP-A-0 818 425 document referred to in the IPER as a particularly pertinent document. We further note that WO 98/40437¹, applied in the obviousness rejection of claims 18, 28 and 35, discloses the combination of phenol-formaldehyde

¹Appellants have not challenged the availability of this reference as prior art to the here claimed invention in the briefs.

resins with other binders such as polyvinyl acetate for mineral wool product application. The examiner should thoroughly review the references of record, including those listed in the IPER to ensure that any rejections that may be maintained subsequent to this remand employ the closest prior art.

In maintaining any obviousness rejections in response to this remand, the examiner must fully respond to any applicable arguments made in the briefs.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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